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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,445	06/29/2001	Yoshifusa Togawa	122.1222RE	6318

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EXAMINER
ELISCA, PIERRE E

ART UNIT	PAPER NUMBER
3621	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
	09/893,445	TOGAWA ET AL.
Office Action Summary	Examiner	Art Unit	
	Pierre E. Elisca	3621	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>18 September 2008</u>.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>67-69,71-76,78-89,91-102 and 104-110</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>67-69,71-76,78-89,91-102 and 104-110</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   This communication is in response to Applicant's election filed on 12/03/2007.

2.   Claims 67-69, 71-76, 78-89, 91-102 and 104-110 are currently pending and

claims 1-66 have been withdrawn.

Claim Rejections - 35 USC § 101

3.   Claims 81, 84, 85, 88, 92 and 109 are rejected under 35 U.S.C. §101 because

the claimed invention is directed to non-statutory subject matter. Based on Supreme

Court precedent[1] and recent Federal Circuit decisions, a §101 process must (1) be tied

to another statutory class (such as a particular apparatus) or (2) transform underlying

subject matter (such as an article or materials) to a different state or thing. See *In re*

Bilski, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a

claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the

thing or product) to which it is tied.   This may be accomplished by having the claim

positively recite the machine that accomplishes the method steps. Alternatively or to

meet prong (2), the method step should positively recite identifying the material that is

being changed to a different state or positively recite the subject matter that is being

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[1]   See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S.
584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v.*
Deener, 94 U.S. 780, 787-88 (1876).

transformed. Applicant is advised to add a machine or computer into the body of the

claims.

In this particular case, the claims fail prong (1) because the method steps are not tied to

a machine and can be performed without the use of a particular machine. As noted

below, a 'process' is not a machine. Additionally, the claims fail prong (2) because the

method steps do not transform the underlying subject matter to a different state or thing.

For example, claim 1 recites "a distributed set of license server processes . . . ." The

Examiner finds that the noun in this phrase is "processes" while "license" and "server" in

this phrase are considered are adjectives. The Examiner finds that the claim therefore

recites "processes" and characteristics of these processes. Because a "process" is not

a machine or apparatus, the claims are not tied to another statutory class.

Claim Rejections - 35 USC § 102

> (e) the invention was described in a patent granted on an application for patent by
> another filed in the United States before the invention thereof by the applicant for patent, or on an
> international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of
> section 371(c) of this title before the invention thereof by the applicant for patent.

4.   The changes made to 35 U.S.C. 102(e) by the American Inventors

Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology

Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent

resulting directly or indirectly from an international application filed before November 29,

2000. Therefore, the prior art date of the reference is determined under 35 U.S.C.

102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5.   Claims 67-69, 71-76, 78-89, 91-102 and 104-110 are rejected under 35 U.S.C.

102 (e) as being anticipated by Cozza (U.S. Pat. No. 5,502,815).

As per claims 67-69, 71-76, 78-89, 91-102 and 104-110 Arnold discloses a

method/apparatus for increasing the speed at which computer viruses are detected

stores initial state information concerning the file or volume which is being examined for

a virus. This information is stored in a cache in a non-volatile storage medium and when

files are subsequently scanned for viruses, the current state information is compared to

the initial state information stored in the cache. Please note that the file can be infected

with virus or without virus, the system comprising:

A virus scanner scanning a file stored in a storage device for infection with a virus, a

quarantining device quarantining the file from non-infected filed on the storage device,

when the file is infected (see., abstract, col 1-col 5. Please note that the limitation of

quarantining the file is readable as isolating the infected virus see., Arnold in col 7, lines

3-8, specifically wherein said if one or more decoy programs is subsequently found to

have changed from the original, protected version, it can be assumed that the changes

are due to a virus. A comparison of each modified decoy program with its corresponding

uninfected version enables a copy of the virus to be isolated from each decoy).

Applicant's newly added limitation of converting device converting the quarantined file

into encoded data is also disclosed by Arnold in col 1, lines 45-63, specifically wherein

said converting the binary machine code of the virus (or infected virues) to an

assembler version, analyzing the assembler code, selecting sections of code that

appear to be unusual or virus like..).

As per claims 68, 71, and 83 Arnold discloses the claimed limitations wherein the

storage device comprises at least one section dedicated to storing infected files (see.,

col 1-col 5).

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 67-69, 71-76, 78-89, 91-102 and 104-110 are rejected under 35 U.S.C.

103 (a) as being unpatentable over Arnold et al. (U.S. Pat. No. 5,440,723) in view of

Cozza (U.S. Pat. No. 5,502,815).

As per claims 67-69, 71-76, 78-89, 91-102 and 104-110 Arnold discloses a

periodic monitoring of a data processing system for anomalous behavior that may

indicate the presence of an undesirable software entity such as a computer virus (which

is readable as Applicant's claimed invention wherein said a data processing system

which has the ability to deal with infection of a file with a virus), the system comprising:

A storage device storing files (see., abstract, fig 1A, items 24 and 26, col 3, lines 49-68);

A virus scanner detecting if a file stored in said storage device is infected with a virus

(see., col 1, lines 45-68, col 2, lines 1-11, col 5, lines 29-45); and Applicant's newly

added limitation of converting device converting the quarantined file into encoded data

is also disclosed by Arnold in col 1, lines 45-63, specifically wherein said converting the binary machine code of the virus (or infected virues) to an assembler version, analyzing the assembler code, selecting sections of code that appear to be unusual or virus like..). Arnold fails to explicitly disclose the limitation wherein said saving or storing a detected virus-infected file into a specific area within said storage device. However Cozza a method/apparatus for increasing the speed at which computer viruses are detected stores initial state information concerning the file or volume which is being examined for a virus. This information is stored in a cache in a non-volatile storage medium and when files are subsequently scanned for viruses, the current state information is compared to the initial state information stored in the cache (see., abstract, col 1-col 5. Please note that the file can be infected with virus or without virus). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the computer virus of Arnold by including the limitation detailed above as taught by Cozza because this would increase the speed at which a computer can scan for the presence of a computer virus.

RESPONSE TO ARGUMENTS

8.   Applicant's arguments with respect to claims 67-69, 71-76, 78-89, 91-102 and 104-110 have been fully considered but they are not persuasive.

REMARKS

9.   In response to Applicant's arguments filed on 12/03/2007, Applicant continue to

argue that:

a.   Arnold says nothing about "a storage device storing files and a file stored in said

storage device is infected with a virus". However, it is the Examiner's principal position

that Cozza discloses a method for increasing the speed at which computer viruses are

detected stores initial state information concerning the file or volume which is being

examined for a virus. **This information is stored in a cache in a non-volatile storage

medium and when files are subsequently scanned for viruses (see., abstract).**

b.   Applicant further argues that the prior art of record (Arnold and Cozza) fail to

disclose the limitation of saving a detected virus. As indicated above, Cozza discloses

this limitation in col 4, lines 59-67, fig 4, step 60, the detected virus is stored **or saved** in

a cache in a non-volatile storage medium. Also, Arnold discloses an automatic scanning

for occurrences of known types of undesirable software entities and taking remedial

action if they are discovered. Therefore, the detected virus is stored in a signature

database, see., Arnold, abstract.

c.   Applicant's newly added limitation of "converting device converting the

quarantined file into encoded data" is also disclosed by Arnold in col 1, lines 45-63,

specifically wherein said converting the binary machine code of the virus (or infected

virues) to an assembler version, analyzing the assembler code, selecting sections of

code that appear to be unusual or virus like..).

Conclusion

10.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 571 272 6706. The examiner can normally be reached on 6:30 to 5:00. Hoteler.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571 272 6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ Pierre E. Elisca/
Primary Examiner, Art Unit 3621